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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,581	05/10/2001	James L. Warmus	27600/M239A	6089

29471 7590 01/28/2003

MCCRACKEN AND FRANK
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SUITE 2150
CHICAGO, IL 60606

EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,581

Applicant(s)

Warmus et al.

Examiner

Stephen Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 13, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Part III DETAILED ACTION

1. This action is responsive to communications: amendment filed on November 13, 2002 to the application, filed on May 10, 2001, which is a Div of 08/802,337 filed 2/11/97, which is a C.P. of 08/478,397 filed 6/7/95, which is a C.P. of 08/724 filed 4/2/96; prior art, filed on September 17, 2001.
2. Claims 1-13 are pending in the case. Claim 1 is an independent claim.

Specification

3. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[©] of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claims 1, 3, 4, 6, 7 and 10-12 remain rejected under 35 U.S.C. 102(e) as being anticipated by de Heus et al., U.S. Pat. No. 5,390,354, 2/95

As per independent claim 1, de Heus teaches the claimed method of assembling a book including:

specifying pagination information including an indication of whether a page is to be selectively included in the book; determining whether the page is to be assembled into the book based on the pagination information; and generating page description language instructions for production of the book in accordance with the pagination information (col.3, lines 25 to col.4, line 14).

As per dependent claims 3, 4, 6, 7 and 10-12, de Heus further teaches:

- analyzing press commands directed to production of the book to determine whether the page is to be assembled into the book (col.3, lines 25-60, "The final book layout... can be printed directly on output devices... us[ing] Adobe TM Postscript ...[or] non-Postscript");

- the step of generating a pagination file having data representative of the pagination information (col.3, line 68, "commands are combined ...that can be interpreted...");

- wherein the pagination information includes a specification of wherein the page should be forced to one of a right side and a left side of the book (col.6, lines 8-28);

- wherein the method further include delivering the page description language instructions to an electronic press to print the book (col.3, line 39, "form a complete page image may be implemented either in the Host Publishing system or in a Digital Graphics..");

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- the step of generating page description language instructions further comprises the step of generating instructions for insertion of filler pages in accordance with pagination information (col.5, line 31-62).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103^o and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 5, 8, 9 and 13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over de Heus et al.

As per dependent claim 2, de Heus does not explicitly disclose analyzing variable information areas of the page. Nevertheless, as Applicant points out in the background section of the present application (e.g, on page 2), it was extremely well known in the art to provide variable information areas in a page of a book. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included the step

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of analyzing the variable area in de Heus, since it would have allowed de Heus to process generating books that use the well known variable page processing techniques.

As per dependent claim 5, de Heus does not explicitly disclose that the pagination information includes an indication of a maximum number of pages for the book. Nevertheless, de Heus discloses including maximum display area per page, maximum filler, minimum filler (col.5, line 53+) and points out that the system recognizes the quantity of pages of the book (col.5, line 52). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have include the information of the maximum number of pages for the book, since de Heus suggested that the size limitation of the whole document must be determined by limiting other factors such as the filler page numbers.

As per dependent claims 8 and 9, although de Heus does not teaching using the barcode on the pages for the tracking information. The use of barcode for tracking document pages was extremely well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the well known tracking means in the disclosed invention of multiple page document generation.

As per dependent claim 13, de Heus does not teach that the method include the step of providing a user interface for entry of the pagination information. Nevertheless, de Heus teaches the system in Figure 1 which accepts the pagination information from the Host interface. Since de Heus also teaches that the information is generated by the Host Publishing system (col.3, lines 25 +), it would have been obvious to a person of ordinary skill in the art

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at the time the invention was made to have envisaged that the host system be provided with a means for the operator to input the data including the pagination data.

Response to Arguments

8. Applicant's arguments filed November 13, 2002 have been fully considered but they are not persuasive.

On page 6 of the amendment, Applicant argues that "De Heus et al. does not disclose or suggest a method of assembling a book including the steps of specifying pagination information including an indication of whether a page is to be selectively included in the book and determining whether the page is to be assembled into the book based on the pagination information, as recited by claims 1-13."

The argument is not persuasive. De Heus et al in fact discloses the feature, since De Heus et al. explicitly pointed out that "[e]ach entry should be provided with typographic information for pagination and typesetting. (col.3, line 48)" Therefore, by definition, the entries that are to be part of the pages in the book will contain the information of the pagination. Therefore, the existence of the pagination information is the "indication" that the entry and its page be included in the book.

Conclusion

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

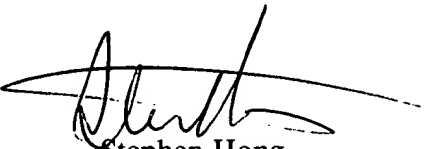
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

After-final	(703) 746-7238
Official	(703) 746-7239
Non-Official/Draft	(703) 746-7240

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

January 24, 2003